

REMARKS

I. Status of the Claims

Claims 1-117 are pending. Without prejudice or disclaimer, claims 1, 27, 60, 89, and 115-117 are amended herein. Specifically, claims 1, 89, and 115-117 are amended to recite that the cosmetic composition further comprises at least one rheological agent and a particulate phase, claim 27 is amended to recite that the cosmetic composition further comprises a particulate phase, and claim 60 is amended to recite that the cosmetic composition further comprises a rheological agent. In addition, claim 1 is amended to remove the gloss limitation. Support for these amendments can be found in the specification and claims as-originally filed, *e.g.*, claims 27 and 60 and specification as-published (U.S. Patent Application Publication No. 2004/0126350 A1) at ¶¶ [0068] and [0092]. Thus, no new matter is presented.

II. Rejections Under 35 U.S.C. § 102

A. Arnaud

The Examiner rejects claims 1-6, 10-13, 24-32, 36-39, 50-65, 69-72, 83-84, 86-94, 98-101, and 112-118 under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 5,961,998 to Arnaud et al. ("Arnaud"). *See* Oct. 23, 2007, Final Office Action at 2-4.

According to the Examiner, "Arnaud teaches glossy compositions, specifically make-up compositions intended for use [o]n the skin and mucous membranes such as the lips." *Id.* at 2 (citing Arnaud, Abstract and col. 1, lines 5-19). The Examiner notes that Arnaud teaches using 5 to 80% of one or more oils with an aromatic group, including PDM 1000 and PCR 15M30, which allegedly are disclosed in the instant

specification and allegedly read on the claimed at least one high viscosity phenylsilicone oil. *See id.* (citing Arnaud, col. 3, line 14 – col. 4, line 44).

The Examiner also notes that Arnaud discloses that the compositions also contain another type of oil, which includes synthetic esters such as diisostearyl malate and triisocetyl citrate and which may be present in an amount ranging from 5 to 30%. *See id.* at 3 (citing Arnaud, col. 5, line 21 – col. 6, line 6).

Addressing the claim limitation that the composition contains less than 5% by weight, relative to the total weight of the composition, of a volatile oil, the Examiner argues that Arnaud only uses a non-volatile hydrocarbon solvent. *See id.* at 3.

The Examiner argues that the post-trial staying power is inherent because Arnaud contains the same ingredients as the claimed composition. *See id.*

Applicants respectfully traverse the rejection for at least the following reasons.

A reference anticipates a claim only if “each and every element as set forth in the claim is found, either expressly or inherently described.” *See* M.P.E.P. § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)). As Arnaud does not teach each and every element of the present claims, this rejection is improper and Applicants respectfully request that it be withdrawn.

The claimed cosmetic composition, as-amended, recites at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt, at least one non-volatile hydrocarbon oil having a molecular mass of more than 500 g/mol, at least one rheological agent, and a particulate phase, wherein the composition has a post-trial staying power of more than 40 out of 100 and contains less than 5% by weight, relative to the total weight of the composition, of a volatile oil.

In contrast to the claimed invention, Arnaud contains an ingredient not present in the claimed composition's ingredients. Specifically, Arnaud describes a cosmetic composition containing a thickener comprising at least one polysaccharide ether. *See* Arnaud, col. 2, lines 2-4. Preferably, "the polysaccharide ether is an alkyl ether of a gum and more particularly of a gum which is nonionic overall." *Id.* at col. 2, lines 52-54. In a preferred embodiment, the polysaccharide ether is a guar gum derivative, such as ethylated guar. *See id.* at col. 2, lines 62-66. The composition of Arnaud, therefore, comprises a liquid fatty phase comprising at least one aromatic group-containing oil, a particulate phase, in addition to a thickening agent comprising at least one polysaccharide ether. However, such a polysaccharide ether is not required to be present in the instant composition. Thus, Arnaud clearly teaches an additional component in the disclosed composition, and, therefore, does not teach a composition identical to the present composition.

Because the compositions of Arnaud and the claimed invention are not identical, not every composition will necessarily and inevitably have the claimed post-trial staying power, and Arnaud does not inherently teach or suggest the claimed invention. *See* M.P.E.P. § 2112 ("The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.") (emphasis added, citations omitted); *see also Electro Med. Sys., S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 1052, 32 U.S.P.Q.2d 1017 (Fed. Cir. 1994) ("The mere fact that a certain thing may result from a given set of circumstances is insufficient to prove anticipation.").

While the present claims are written in open claim format, and, therefore, do not exclude the possibility of including a thickener comprising at least one polysaccharide ether in the claimed composition, not every composition that contains the claimed ingredients will necessarily meet the claimed post-trial staying power, especially when the composition necessarily comprises an additional component as does Arnaud.

Accordingly, contrary to the Examiner's position, Arnaud does not inherently, i.e., **necessarily** and **inevitably**, result in the claimed post-trial staying power. For at least this reason, Applicants respectfully request that this rejection be withdrawn.

Moreover, in order to anticipate the claimed invention, Arnaud must clearly and unequivocally disclose the claimed composition to one of ordinary skill in the art "without any need for picking, choosing and combining various disclosures." *In re Arkley*, 455 F.2d 586, 587, 172 U.S.P.Q. 524, 526 (C.C.P.A. 1972). In other words, one of skill in the art must be able to "at once envisage" the invention as claimed. *See* M.P.E.P. § 2131.02. Arnaud discloses that its composition "contains one or more oils containing an aromatic group," which can have a hydrocarbon-based or silicone based skeleton. *See* Arnaud, col. 3, lines 15-17. Further, Arnaud discloses that its composition "contains one or more types of oil other than the oils containing an aromatic group," including "hydrocarbon-based and/or silicone-based and/or fluoro oils." *Id.* at col. 5, lines 21-24. Moreover, in its long list of possible oils including silicone oils, volatile hydrocarbon oils, and volatile silicone oils, Arnaud also teaches non-volatile hydrocarbon oils having a molecular mass of more than 500 g/mol.

Arnaud, however, does not provide any guidance for selecting an oil with a silicone-based skeleton and a non-volatile hydrocarbon oil having a molecular mass or

more than 500 g/mol to the exclusion of the other possible components. One skilled in the art, therefore, would not “at once envisage” the claimed invention. Thus, Applicants respectfully submit that this rejection should be withdrawn for this additional reason.

B. Agostini

The Examiner rejects claims 1-7, 10-33, 36-52, 54-66, 69-84, 86-95, and 98-118 under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent Application Publication No. 2003/0017124 A1 to Agostini et al. (“Agostini”). See Oct. 23, 2007, Final Office Action at 4-5. According to the Examiner, “Agostini teaches a two-coat makeup product for the skin, lips or other integuments that contains two compositions.” *Id.* at 4 (citing Agostini at Abstract and ¶ [0003]). The Examiner notes that the “second composition includes non-volatile liquids such as hydrocarbon based liquids including diisostearyl malate and high and low viscosity silicone oils that meet[] applicants claimed high and low viscosity phenylsiloxane.” *Id.* (citing Agostini at ¶¶ [0152]-[0202]).

Addressing the claim limitation that the composition contains less than 5% by weight, relative to the total weight of the composition, of a volatile oil, the Examiner argues that Agostini only uses a non-volatile solvent. See *id.*

The Examiner argues that the post-trial staying power is inherent because Agostini contains the same ingredients as the claimed composition. See *id.*

Applicants respectfully traverse this rejection for at least the reasons of record. Further, Applicants note that Agostini teaches two compositions to be used in conjunction with each other to form a two-coat cosmetic product. Thus, the claimed post-trial staying power of the product taught by Agostini is not necessarily inherent because Agostini requires the two compositions to be layered on each other. Moreover,

Applicants submit that the Examiner's rejection is now moot in view of amended claims 1, 27, 60, 89, and 115-117, which recite that the cosmetic composition further comprises at least one rheological agent and a particulate phase.

Agostini discloses two separate compositions to form two separate layers. Applicants acknowledge that the first composition contains "polymer particles dispersed and surface-stabilized by means of a stabilizer in a liquid phase . . . and at least one first coloring agent" (Agostini, ¶ [0050]), and the first composition may contain "one or more rheological agents" *Id.* at ¶ [0132]. In contrast, the second composition of Agostini contains "a second physiologically acceptable medium and a second coloring agent," and, preferably, a non-volatile liquid phase. *See id.* at ¶¶ [0149], [0150].

Agostini mentions in passing that:

the physiologically acceptable media for each of the first and second compositions . . . may comprise, in addition to the . . . nonvolatile liquid phase for the second composition, additional fatty substances that may be chosen from waxes, oil, gums and/or pasty fatty substances, that are hydrocarbon-based, silicone based and/or fluoro-based, of plant, animal, mineral or synthetic origin, and mixtures thereof.

Id. at ¶ [0248]. Agostini, however, does not provide any preference for adding a rheological agent, as disclosed and claimed in the instant invention, to the second composition.

Moreover, Agostini mentions that the "physiologically acceptable medium of the second composition may also contain a volatile liquid phase" *Id.* at ¶ [0205]. Agostini, however, does not provide any teaching for limiting the amount of volatile oil present in the composition to less than 5% by weight, as claimed.

Because Agostini does not clearly and unequivocally disclose the claimed composition to one of ordinary skill in the art as claimed, i.e., all limitations in one composition, and further, "without any need for picking, choosing and combining various disclosures" (*In re Arkley*, 455 F.2d at 587,172 U.S.P.Q. at 526), one skilled in the art would not "at once envisage" the claimed invention. *See* M.P.E.P. § 2131.02. Thus, Agostini does not anticipate the claimed invention, and Applicants respectfully submit that this rejection should be withdrawn for at least this reason.

III. Rejection Under 35 U.S.C. § 103(a)

A. Agostini

The Examiner rejects claims 1-118 under 35 U.S.C. § 103(a) as being unpatentable over Agostini. *See* Oct. 23, 2007, Office Action at 7.

The Examiner's reliance on Agostini as prior art is misplaced. For art to be relied upon under 35 U.S.C. § 103(a) as the basis for an obviousness rejection, the art must first qualify as prior art under the definition of 35 U.S.C. § 102. Applicants submit that Agostini is not prior art to the present application and, thus, the rejection is improper.

Applicants' application claims priority of French Patent Application No. 02 11095, filed September 6, 2002, and U.S. Provisional Application No. 60/410,955, filed September 17, 2002. For purposes of § 102(e), Agostini, which published January 23, 2003, has an effective filing date of April 10, 2002. *See* M.P.E.P. 2136.03(l) ("[T]he foreign priority date of the reference under 35 U.S.C. 119(a)-(d) (f), and 365(a) cannot be used to antedate the application filing date."). Accordingly, Agostini is only available as possible § 102(e) prior art.

While Agostini qualifies as § 102(e) prior art, it is not available as prior art for an obviousness rejection pursuant to 35 U.S.C. § 103(c).

35 U.S.C. § 103(c) states that subject matter that qualifies as prior art only under 35 U.S.C. §§ 102(e), (f), and/or (g) is disqualified as prior art against the claimed invention if that “subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” Common ownership may be established by a conspicuous statement indicating that the claimed invention and a § 102(e) reference were, at the time the invention was made, commonly owned or subject to an obligation of assignment to the same person. *See* M.P.E.P. § 706.02(I)(2)(II).

With this in mind, Agostini is not available as prior art, because the present invention and Agostini were, at the time the invention was made, subject to an obligation of assignment to the same person, *i.e.*, L'Oréal. *See* M.P.E.P. § 706.02(I)(2)(II).

Because Agostini is not available as prior art in a § 103(a) rejection of the instant application, Applicants respectfully submit that the Examiner cannot rely upon it to support the pending § 103 rejection. Accordingly, the rejection is improper and Applicants respectfully request that the Examiner withdraw this rejection.

B. Arnaud

The Examiner rejects claims 1-118 under 35 U.S.C. § 103(a) as being unpatentable over Arnaud. *See* Oct. 23, 2007, Office Action at 8-9.

Applicants respectfully traverse for at least the following reasons.

With respect to obviousness, several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims under 35 U.S.C.

§ 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or nonobviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. 467; *see also KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1730, 82 U.S.P.Q.2d 1385, 1388 (2007).

Indeed, to establish a *prima facie* case of obviousness, the Examiner must:

make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

M.P.E.P. § 2142. "The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious."

Id. It is important to note, moreover, that the prior art references relied upon in a rejection "must be considered in its entirety, i.e., as a whole, including portions that

would lead away from the claimed invention," when such reasons are articulated by the Examiner. M.P.E.P. § 2141.03(VI); *see also Graham*, 383 U.S. at 17, 148 U.S.P.Q. 467.

Here, the Examiner has not established a *prima facie* case of obviousness because the claimed invention as a whole would not have been obvious in view of Arnaud, when considered as a whole. Specifically, as discussed above, Arnaud does not teach or suggest, either expressly or inherently, the claimed plateau post-trial staying power and does not provide a basis for modifying the compositions to have such a physical characteristic. Moreover, as discussed above, Arnaud would not have motivated one skilled in the art to select an oil with a silicone-based skeleton and a non-volatile hydrocarbon oil having a molecular mass or more than 500 g/mol to the exclusion of the other possible components identified by Arnaud. For at least these reasons, Applicants respectfully submit that the rejection is in error and should be withdrawn.

Moreover, while Arnaud discloses both high and low viscosity phenylsiloxanes, one skilled in the art reading Arnaud would not have been motivated to used both a high and low viscosity phenylsiloxane in combination. Indeed, the Examiner even concedes that Arnaud "is silent on the use of a low and high viscosity phenylsiloxanes in combination." Oct. 23, 2007, Office Action at 9. Accordingly, for at least this additional reason, Applicants respectfully submit that the rejection should be withdrawn.

C. Arnaud in view of Willemin

The Examiner rejects claims 1-118 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Arnaud in view of U.S. Patent No. 6,592,855 to Willemin et al.

("Willemin"). See Oct. 23, 2007, Office Action at 9-10. The Examiner relies on Arnaud for the reasons stated above, but concedes that Arnaud "is silent on the use of a low and high viscosity phenylsiloxane[] in combination." See *id.* at 9. The Examiner relies on Willemin to allegedly cure this deficiency, arguing that "low viscosity phenylsiloxanes were well known in the art to be useful in cosmetic formulations." *Id.*

Applicants respectfully traverse for at least the following reasons.

One skilled in the art would not have been motivated to combine the low viscosity phenylsiloxane of Willemin (see Willemin, col. 2, lines 25-51) with the composition of Arnaud. In particular, the Examiner's unsupported statement that low viscosity phenylsiloxanes were well-known in the art is insufficient to provide the necessary motivation to combine the references, especially considering that neither reference provides any motivation to combine both high and low viscosity phenylsiloxanes in a single composition.

Moreover, as discussed above, Arnaud teaches an additional ingredient, a thickener comprising at least one polysaccharide ether, which is not present in the claimed composition. Thus, even if one skilled in the art was motivated to combine the composition of Arnaud with the low viscosity phenylsiloxanes of Willemin, as the Examiner suggests, the resulting composition would not necessarily and inevitably have the claimed post-trial staying power.

Accordingly, Applicants respectfully submit that the rejection is in error and should be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants, therefore, request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

If the Examiner believes a telephone conference could be useful in resolving any outstanding issues, he is respectfully invited to contact Applicants' undersigned counsel at (202) 408-4152.


Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 24, 2008

By: _____


Aaron M. Raphael
Reg. No. 47,885